



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/977,846	11/25/1997	JOHN O. RYAN	M-2338-3C-US	3572

25226 7590 09/01/2004
MORRISON & FOERSTER LLP
755 PAGE MILL RD
PALO ALTO, CA 94304-1018

EXAMINER

DIXON, THOMAS A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 08/977,846	Applicant(s) RYAN, JOHN O.	
	Examiner Thomas A. Dixon	Art Unit 3629	<i>MLW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 33-59 is/are pending in the application.
- 4a) Of the above claim(s) 2-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 33-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's remarks of 4/30/04 have been considered and are convincing as regards the 101 rejection. The art rejections are maintained and the allowability of claims indicated in the previous action is withdrawn in view of De Bey (WO 99/03112).
2. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 1, including tuner, memory, user interface, controller and speech subsystem are disclosed in De Bey and Lang as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 33-39, 41-44, 52, 56, 58-59 are rejected under 35 U.S.C. 102(b) as being anticipated by De Bey (WO 99/03112).

As per Claim 1.
De Bay ('112) discloses:

Art Unit: 3629

a tuner for receiving a broadcast signal, see figure 2 (40) and page 10 lines 26-27 and page 11, lines 4-5;

a memory coupled to the tuner for storing data in the received broadcast signal in a database, see figure 2 (42, 42);

a user interface for providing a set of menus describing the database, and for accepting selections from the set of menus, see figure 2 (54, 44);

a controller coupled to the memory and the user interface for selecting data from the database in response to the accepted selections and providing the selected data in a digital form, see figure 2 (52) and page 9, lines 10-11, page 19, lines 32-33;

a speech producing sub-system coupled to the controller and the memory for converting the selected data from digital form to an analog signal, see page 11, lines 16-17, page 8, line 4, see page 9, line 11.

As per Claim 33.

De Bay ('112) further discloses the memory stores the entire database, see page 7, lines 1-33 and page 11, lines 12-15.

As per Claim 34.

De Bay ('112) further discloses the memory comprises a combination of volatile RAM and non-volatile memory, see page 7, lines 10-33 and page 11, lines 12-15.

As per Claim 35.

De Bay ('112) further discloses non-volatile memories such as ROM, see page 7, lines 10-33 and page 11, lines 12-15.

As per Claim 36.

De Bay ('112) further discloses the received audio data has been converted from analog form to digital form, see page 9, lines 36-38.

As per Claim 37.

De Bay ('112) further discloses the received audio data is digitized and has been compressed, see page 9, lines 36-38.

As per Claim 38.

De Bay ('112) further discloses the received audio data is encrypted, see page 11, lines 30-38.

As per Claim 39.

De Bay ('112) further discloses the received data converted from analog form to digital form, see page 9, lines 5-11.

As per claim 41.

Art Unit: 3629

De Bay ('112) further discloses the data is in digital form, see page 9, line 11, encrypted, see page 11, lines 30-31, and compressed, see page 11, line 12, and further comprising a decryptor for decrypting, see page 11, lines 31-32.

As per Claim 42.

De Bay ('112) further discloses a decompression algorithm to decompress data that has been compressed at a transmitter prior to being broadcast, see figure 2 (40, 50), and page 111, lines 12-15.

As per Claim 43.

De Bay ('112) further discloses the decryptor is enabled by a key received by the tuner, see page 11, lines 31-33, 35-38 and page 12, line 1.

As per Claim 44.

De Bay ('112) further discloses the decryptor is enabled by a key received by the tuner, see page 11, lines 31-33, 35-38 and page 12, line 1, states that the key can be included as a prefix to the data packet received by the receiver 40.

As per Claim 52.

De Bay ('112) further discloses the memory stores the data received in a random access memory up to the capacity of the random access memory before transmitting said data to one of a disk medium or tape medium, see page 7, lines 23-25.

As per Claim 56.

De Bay ('112) further discloses optical disk, see page 7, line 27.

As per Claim 58.

De Bay ('112) discloses:

receiving the information, see page 6, line 33 and page 3, line 28;

storing the received information, see page 7, lines 1-9 and page 3, line 29;

providing a set of menus describing the database, see page 8, lines 3-6;

accepting selections from the set of menus, see page 8, lines 3-6;

selecting data from the database in response to the accepted selection, see page 8, lines 6-14;

providing the selected data in digital form, see page 9, lines 9-11; and

converting the selected data to an analog signal, see page 8, lines 33-38.

As per Claim 59.

De Bay ('112) further discloses broadcast, see page 6, line 36

4. Claims 1, 33-37, 49, 52, 54-56, 58-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Lang (5,057,932).

Art Unit: 3629

As per Claim 1.

Lang ('932) discloses:

a tuner for receiving a broadcast signal, see figure 3 and column 11, lines 9-40;
a memory coupled to the tuner for storing data in the received broadcast signal in a database, see figure 3, (13), column 8, lines 38-50 and column 11, line 30 ;

a user interface for providing a set of menus describing the database, and for accepting selections from the set of menus, see column 11, lines 32-40 and column 8, lines 27-33;

a controller coupled to the memory and the user interface for selecting data from the database in response to the accepted selections and providing the selected data in a digital form, see figure 3 (14);

a speech producing sub-system coupled to the controller and the memory for converting the selected data from digital form to an analog signal, see figure 3 (12).

As per Claim 33.

Lang ('932) further discloses the memory stores the entire database, see column 8, lines 27-33.

As per Claim 34.

Lang ('932) further discloses the memory comprises a combination of volatile RAM and non-volatile memory, see figure 3 (13, 14).

As per Claim 35.

Lang ('932) further discloses non-volatile memories such as ROM, see figure 3 (14).

As per Claim 36.

Lang ('932) further discloses the received audio data has been converted from analog form to digital form, see figure 3 (A/D, D/A) and column 5, lines 51-53.

As per Claim 37.

Lang ('932) further discloses the received audio data is digitized and has been compressed, see figure 3 (A/D, D/A) and column 3, line 51 - column 5, line 50.

As per Claim 49.

Lang ('932) further discloses an amplifier connected to the speech producing sub-system for amplifying the analog signal, see column 11, lines 60-63.

As per Claim 52.

Lang ('932) further discloses a memory stores the data received in a random access memory up to the capacity of the random access memory before transferring said data to one of a disk medium or a tape medium, see column 9, lines 38-56.

As per Claim 54.

Art Unit: 3629

Lang ('932) further discloses disk medium is a magnetic disk, see column 6, line 28-39.

As per Claim 55.

Lang ('932) further discloses disk medium is a magnetic-optical disk, see column 6, line 28-39.

As per Claim 56.

Lang ('932) further discloses disk medium is an optical disk, see column 6, line 28-39.

As per Claim 58.

Lang ('932) discloses:
receiving the information, see figure 3 and column 11, lines 9-40;
storing the received information in a database, see column 11, line 30;
providing a set of menus describing the database, see column 11, lines 32-40 and column 8, lines 27-33;
accepting selections from the set of menus, see column 8, lines 27-33;
providing the selected data in digital form, see column 8, lines 5-26; and
converting the selected data to an analog signal, see column 8, lines 38-50.

As per Claim 59.

Lang ('932) further discloses the received information is transmitted by a broadcast signal, see figure 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 38, 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang ('932) in view of Rovira (WO 92/10040).

As per Claim 38.

Lang ('932) does not disclose the received audio data has been encrypted.

Art Unit: 3629

Rovira ('040) teaches conversion, compression and encryption of data are well known for the benefit of increased speed and security of data transmission, see page 12, lines 5-16.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to digitize and encrypt the data transmission for the benefit of increased security of data transmission.

As per Claim 41.

Lang ('932) does not disclose a decryptor for decrypting the data.

Rovira ('040) teaches conversion, compression and encryption of data are well known for the benefit of increased speed and security of data transmission, see page 12, lines 5-16 and further a decryptor for decrypting, see page 14, lines 7-12 for the benefit of reversing the encryption, compression and conversion of the broadcast data.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to decrypt the data transmission for the benefit of reversing the encryption, compression and conversion of the broadcast data.

As per Claim 42.

Lang ('932) further discloses a decompression algorithm for decompressing the data, see figure 3 (26).

6. Claims 39-40, 45-48, 50-51, 53, 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang ('932) in view of Official Notice.

As per Claim 39.

Lang ('932) teaches an analog to digital and digital to analog converters are old and well known, see figure 3 (24, 25), but does not disclose or fairly teach the received data is alphanumeric data and has been converted from analog to digital form.

Official Notice is taken that it is old and well know to convert data from analog to digital, the type of data does not matter, further Atkinson "VCR programming: Making life easier using bar codes" and further Bensch "VPV – Videotext programs videorecorder" teaches use of alpha numerics in vcrrs, for the benefit of making vcrrs easier to set.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to convert alphanumeric data to digital form for the benefit of easier setting of the vcr.

As per Claim 40.

Lang ('932) teaches an analog to digital and digital to analog converters are old and well known, see figure 3 (24, 25), but does not disclose or fairly teach the received data is alphanumeric data and is converted to voice data by a speech synthesizer.

Art Unit: 3629

Official Notice is taken that it is old and well know to convert data from analog to digital, the type of data does not matter, further it is well know for radios and televisions to have voice for the benefit of listening to the audio portion of the program.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to convert alphanumeric data to digital form and convert voice data by a speech synthesizer for the benefit of listening to the audio portion of the program.

As per Claim 45.

Lang ('932) does not disclose the user interface is voice activated.

Official Notice is taken that speech recognition is old and well know as shown in Takahashi (4,682,368), column 2, lines 11-60 for the benefit of hands free operation of the device.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include a voice activated user interface as taught by Takahashi (4,682,368) for the benefit of hands free operation of the device.

As per Claim 46.

Lang ('932) does not disclose:

a manual input device adapted to be mountable on an automobile steering wheel; and

a link from the manual input device to the controller.

Official Notice is taken that control systems on automobile steering wheels are well known, as seen in Guenther et al (5,086,510) figure 4, for the benefit of better visibility of controls for the user.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to mount controls on an automobile steering wheel and link it to the controller for the benefit of better visibility of the controls for the user.

As per Claim 47.

Lang ('932) does not disclose a control for determining the speed at which the speech output device outputs the analog signal.

Official notice is taken that it is old and well known to determine the speed at which the speech device output the output signal as can be seen in Benbassat et al (4,700,322) column 1, lines 28-50 for the benefit of synchronizing speech with the visualization of messages.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to determine the speed at which the speech device output the output signal as taught by Benbassat et al (4,700,322) for the benefit of synchronizing speech with the visualization of messages.

As per Claim 48.

Lang ('932) does not disclose the tuner channel skips to tune to a particular transmitter.

Art Unit: 3629

Official Notice is taken that it is old and well known to skip channels to get to the desired transmitter, as seen in Whitby et al (GB 2 258 102) page 6, lines 13-21 for the benefit of presetting the device to access a specific transmitter.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to skip channels to get to the desired transmitter, as taught by Whitby et al (GB 2 258 102) for the benefit of presetting the device to access a specific transmitter.

As per Claim 50.

Lang ('932) does not disclose connecting the receiving system to an automobile radio set.

Official Notice is taken that control systems on automobile are well known, as seen in Guenther et al (5,086,510) figure 4, for the benefit of better visibility of controls for the user.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to mount controls on an automobile steering wheel and link it to the controller for the benefit of better visibility of the controls for the user.

As per Claim 51.

Lang ('932) does not disclose a hierarchy for the database.

Official Notice is taken that hierarchical databases are old and well known, as taught by Date "An introduction to Database Systems" in the database arts for structured storage.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to create a hierarchical database as an old and well known method of structuring a database.

As per Claim 53.

Lang ('932) further discloses a tape medium and various digital media, see column 3, lines 51-56 and column 6, line 28-39, but does not disclose digital audio tape.

Official Notice is taken that it is old and well known to use standardized media for recording for the benefit of maximizing public acceptance of the product.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to utilize digital audio tape or any other standard media for recording for the benefit of maximizing public acceptance of the product.

As per Claim 57.

Lang ('932) does not disclose a speed of transmission of the data in the broadcast signal is varied to most efficiently use the available bandwidth.

Official Notice is taken that it is old and well known in the network arts to vary transmission speeds to most efficiently use the available bandwidth.

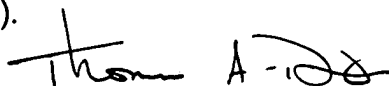
Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to vary the transmission of the broadcast signal to most efficiently use the available bandwidth.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas A. Dixon
Primary Examiner
Art Unit 3629

August 04